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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/806,309 | 03/22/2004 | Michael J. Czaplicki | 1001-112C1 | 1828 |

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| EXAMINER |
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SELLERS, ROBERT E

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/806,309 | CZAPLICKI ET AL. | |
| | Examiner | Art Unit | |
| | Robert Sellers | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 20-24, 27-32 and 34-36, drawn to a method of providing reinforcement, acoustical damping or sealing to a member of an article of manufacture with a synthetic material comprising a tacky base material and a non-tacky polymeric powder, classified in class 156, subclass 303.1.
 - II. Claims 25, 26 and 43, drawn to the method of Group I further comprising applying release paper to the tacky surface of the synthetic material (claim 25) and removing it (claim 26), classified in class 156, subclass 323.
 - III. Claims 33, 37, 38 and 40-42, drawn to the method of Group I wherein the base material includes a curing agent, classified in class 156, subclass 307.1.
 - IV. Claim 39, drawn to the method of Group III further comprising applying a release paper to the synthetic material and removing it, classified in class 156, subclass 327.
2. The inventions are independent or distinct from each other because the additional application and removal of release paper to the tacky surface of the synthetic base material in Group II constitutes a materially different additional manipulation of the synthetic material from Group I. The further inclusion of the curing agent in the base material of Group III irreversibly changes the structure of the applied synthetic material of Group I or II.

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The additional application and removal of release paper to the synthetic base material of Group IV with a curing agent of Group III yields a materially different additional process step from the method of Group I or III.

Restriction for examination purposes as indicated is proper because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification.

3. This application contains claims directed to the following patentably distinct species:

(a) The polymeric base materials such as the bisphenol A-epichlorohydrin ether polymer described on page 6, lines 14-16 of the specification.

(b) The polymeric base materials with or without the blowing agent of claims 32 and 43.

(c) The correspondence components such as the bisphenol A epoxy resin disclosed on page 7, lines 29-31.

(d) Contingent upon the election of Group III or IV, items (a), (b) and (c) hereinabove and the curing agents wherein a single species is elected from such particularly preferred types as triethylenetetramine, diethylenetriamine, tetraethylenepentamine, cyanoguanidine and dicyandiamide (page 10, lines 24-27).

4. The species are independent or distinct because the myriad species of polymeric base materials as defined in claims 24 and 38, the diverse types of correspondence components denoted in claims 36 and 42, the presence or absence of a blowing agent, and the presence or absence of a curing agent necessitates multiple burdensome searches.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species ***within each of items (a), (b), (c) and, if applicable, (d)*** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 20-43 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. (MPEP § 809.02(a)).

A telephone call was made to Scott A. Chapple on June 19, 2006 to request an oral election to the above restriction and election of species requirements, but did not result in elections being made.

The reply to this requirement to be complete must include (i) an election of species and invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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5. The specification on page 1 does not indicate that "This application is a continuation of application no. 10/217,991 filed August 13, 2002, U.S. Patent No. 6,811,864."
6. There is no support for the method of providing baffling in independent claims 20, 37 and 43 in line 2 since page 2, lines 31-33 and page 13, lines 25-27 merely describe a method of providing reinforcement or acoustical damping.
7. There is no antecedent basis in claim 20 for "the contacting of the non-tacky surface" in claim 22 wherefrom it depends.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712